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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,462	08/13/2001	Charles E. Schwarz JR.	47004.000142	4155

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EXAMINER	
PAIK, STEVE S	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/927,462	SCHWARZ, CHARLES E.	
	Examiner	Art Unit	
	Steven S. Paik	2876	

-- The MAILING DATE of this communication app ars on the cover sheet with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 18, 2004 has been entered.

Response to Amendment

2. Receipt is acknowledged of the Amendment filed May 18, 2004. The Amendment includes amended claims 36, 38, 39, 41-43, 50, and 52-54 and newly added claims 55-58.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 50 recites the limitation "the second reward" in line 11. There is insufficient antecedent basis for this limitation in the claim. The examiner respectfully suggests replacing it with -- a second reward -- to overcome the insufficient antecedent basis issue. Dependent claims 51-53 and 57 are rejected due to their dependent relationship with Claim 50.

5. Claim 54 recites the limitation "the second reward" in line 6 on page 7 of the Amendment. There is insufficient antecedent basis for this limitation in the claim. The examiner respectfully suggests replacing it with -- a second reward -- to overcome the insufficient antecedent basis issue. Furthermore, the claim recites "a second account" in line 3 on page 7 without reciting a first account previously. The Examiner interprets that the applicant

intends to associate the pre-funded with an individual account. If that is what the applicant intends to claim, then it is respectfully suggested to amend the claim to precisely and particularly claim the intended steps. Dependent claim 58 is rejected due to its dependent relationship with Claim 54.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 36, 39-41, and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr. (US 6,078,888) in view of Walker et al. (US 6,128,599).

Re claims 36, 39, and 41, Johnson, Jr. discloses a tag (RF transponder 100) which is linked to a credit card (tag holder's) to pay for a service, goods, and/or tolls (col. 1, ll. 29-37; in case of a tag for an ETC, it is pre-funded with a preset amount. If the pre-funded amount reaches lower than a predetermined limit, it is replenished by either electronic transfer or cash deposit. Tollbooths in different regions under different administration may be linked to accept one tag for many different tollbooths located and administered under a different administration). Johnson, Jr. further discloses that the tag can be used in association with a loyalty program (col. 12, ll. 10-14) where customers (tag holders) collect bonus points based on the aggregated usages (via purchases and transactions. The aggregated usage (total amount of each aggregated usages such as paying for tollbooths or pumping gases, are transmitted to a financial institution that manages

the credit card account. Therefore, the host computer of the financial institution at least in directly aggregates the tag usages and considers the total amount when calculating a predetermined reward.). The bonus points can be redeemed as desired for benefits or privileges at the fuel station store or any other local source. As appreciated by an artisan of ordinary skill in the art, many different tags having different and unique functions such as purchasing gas or goods at a fuel station store or paying tolls at a toll gate, may be linked to a single credit card. For example, a family owning more than one automobile may have different tags for each car to pay for gasoline, services, goods, and tolls. They would prefer linking the different tags to a single credit card account for accelerated accumulation of air mileages, purchasing gas at a discounted price, more charitable donations or the like. In general, tags for ETC have different appearance than tags for a fuel store because of their differences in names, logos, and designs.

Although Johnson, Jr. discloses the steps of aggregating tag usage and calculating a reward based on the aggregate tag usage, he does not specifically disclose the how a tag is associated with one collective account.

Walker et al. disclose a method and apparatus for calculating and attributing a customized reward offers to an affinity group of a credit card holder (col. 2, ll. 50-67). Based on the specific criteria of affiliated account holders and method for generating a customized reward offer, the affinity group or a member of the affinity group may receive a predetermined reward. Many credit card issuers offer credit card accounts sponsored by an affinity partner. Theses credit card issuers believe a credit card holder who is a member of an affinity group is more likely to use his account if it benefits the affinity group sponsor. Credit card issuers further expect higher response rates and reduced attrition rates for credit card accounts sponsored by an affinity

partner. Examples of affinity group sponsors include trade groups, alumni associations, religious organizations (charitable organization), sports teams and professional associations (col. 1, ll. 30-38).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a method of processing customized group reward offers, as taught by Walker et al. in addition to the tags or transponders having association with a credit/debit card of Johnson, Jr. due to the fact that more ways to contribute to a credit card holder's affinity group can be established for the purposes of giving more options to a credit card holder and more retaining opportunities of customer base to a credit card issuer.

Regarding claim 40, Johnson, Jr. in view of Walker et al. discloses the system and the method as recited in rejected claim 36 stated above, wherein the tagholder selects the organization (a tagholder has an option to link a credit card of his choice with the tag).

Regarding claim 44, Johnson, Jr. in view of Walker et al. discloses the system and the method as recited in rejected claim 36 stated above, where at least one tags comprises at least one communication port (I/O port 124 in Fig. 2A of Johnson, Jr.) allowing the at least one of the tags to communicate with other devices.

Regarding claim 45, Johnson, Jr. in view of Walker et al. discloses the system and the method as recited in rejected claim 36 stated above, where at least one tags comprises a microprocessor (116 communication controller in Fig. 2a).

Regarding claim 46, Johnson, Jr. in view of Walker et al. discloses the system and the method as recited in rejected claim 36 stated above, where at least one tags comprises a transmitter (106 transmitter in Fig. 2a).

Regarding claim 47, Johnson, Jr. in view of Walker et al. discloses the system and the method as recited in rejected claim 36 stated above, where the plurality of tags further comprises at least one of a smart card, a bar coded sticker, a transponder (100) readable by a reader/antenna (110 or 112) or combinations thereof.

8. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr. (US 6,078,888) as modified by Walker et al. (US 6,128,599) as applied to claim 36 above, and further in view of Khan et al. (US 6263,316).

Regarding claims 37 and 38, the teachings of Johnson, Jr. in view of Walker et al. have been discussed above which includes all the features of claimed invention with the exception of recited elements of the plurality of tags.

Although Johnson, Jr. in view of Walker et al. discloses the tag transponder, he does not specifically disclose the tags comprises a sound-generating device.

Khan et al. discloses a transponder (31 in Fig. 3) comprises a sound generating device (39 speaker) for the purpose of alerting its user by generating an audible tone or message. Furthermore, the audible tone or message can be shown via a display screen (34 and col. 3, lines 49-60).

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have incorporated the tag capable of generating an audible tone or message along with a visual message to inform its user the result of data communication, as taught by Khan, in addition to the tag (transponder) of Johnson, Jr. in view of Walker et al. for the purpose of informing a tag holder about the status of data read by a reader with both audible

and visible signal. Accordingly, the tag holder is better informed of current status and more ready to take the next step to complete his intended transactions using the tag and its reader.

9. Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr. (US 6,078,888) as modified by Walker et al. (US 6,128,599) as applied to claim 36 above, and further in view of Akiyama et al. (US 5,745,049).

Regarding claims 42 and 43, the teachings of Johnson, Jr. in view of Walker et al. have been discussed above which includes all the features of claimed invention with the exception of recited elements of the plurality of tags.

Although Johnson, Jr. in view of Walker et al. discloses the tag transponder, he does not disclose the tags comprise an LED and LCD.

Akiyama et al. discloses a tag (transponder 201d in Fig. 8) comprises, among other things, a display (66) using LED or the like and an LCD can be used to show the status, such as "normal condition" or "abnormal condition", etc (col. 10, lines 15-32). It is necessary to have a display means to show a status or data communication in a transponder system. Some of the systems integrate with a reader or interrogator including a display device.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have substituted the tag disclosed in Johnson, Jr. as modified by Walker et al. with a tag disclosed in Akiyama et al. reference since it is an obvious matter of design choice available in the art to design a transponder with a display using an LED and/or LCD. The desired function of displaying a data communication result or status can be achieved in both methods.

10. Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr. (US 6,078,888) as modified by Walker et al. (US 6,128,599) as applied to claim 47 above, and further in view of Ricci et al. (US 6,463,039).

Regarding claims 48 and 49, the teachings of Johnson, Jr. in view of Walker et al. have been discussed above which includes all the features of claimed invention with the exception of recited elements of the plurality of tags.

Although Johnson, Jr. in view of Walker et al. discloses the tag transponder, he does not specifically disclose the tags comprises a mode of the tags being operated.

Ricci et al. discloses a tag (col. 5, ll. 50-57) operates in a full-duplex communications mode. The full-duplex mode allows the transponder to share a communication channel simultaneously with the interrogator. This obviously increase the amount of data transmitted and received and shortens the time required to exchange data. A transponder is inherently comprised a half-duplex mode communication type.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to have incorporated the tag capable of processing a full duplex mode as taught by Ricci et al. for the purpose of increasing amount of data exchanged using the same amount of time. Since both a half duplex and a full duplex mode are known in the art, it is an obvious matter of selecting a required mode according to the specific needs of a user. If a user is interested in increasing communication speed, then he or she will obviously choose a full duplex mode.

Allowable Subject Matter

11. Claims 50 and 54 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. Furthermore, dependent claims 51-53, 57, and 58 would be allowable through their dependency.

Response to Arguments

12. Applicant's arguments filed October 16, 2003 have been fully considered but they are not persuasive.

Claims 36, 39-41, 44-47

The applicant argues that the cited prior arts (USPN 6,078,888; 6,128,599; 5,745,049;6,463,039; 6,263,316) taken alone or in combination with other reference fail to disclose the claimed invention. The examiner respectfully disagrees.

On page 11, the applicant states, "there is no disclosure in Johnson (US 6,077,888) of a first reward attributed to an account calculated by a host computer of a financial institution based on aggregate tag usage of a tag regardless of point of purchase, but rather Johnson discloses loyalty benefits awarded to a tagholder based only on aggregate usage at the business of the sponsor of the loyalty program.". As discussed in this Office Action, a host computer of the financial institution coupled to the tag associated with one of credit card or bank accounts of the financial institution receives the information of aggregated usages of the tag. Therefore, the host computer of the financial institution at least in directly receives the information of aggregated usages of the tag and use it for calculating a first reward. Johnson further discloses that the bonus points may be redeemed as desired for benefits or privileges at the fuel station or any other local source. Therefore, the reference does not limit the redemption of the points aggregated by

usages of the tag. Furthermore, the claims do not recite the limitations applicant argued in the Remark section of the Amendment.

On pages 12 and 13, the applicant argues, "the invention claimed in independent claim 36 is based on the aggregate usage of the tag with multiple merchants". Claim 36 does not recite the aggregating usage of the tag with multiple merchants. In addition, the cited references read on the claimed limitation since the tag in the reference aggregates the usage with at least one merchant.

Claims 37, 38, 42, 43, 48 and 49

Dependent claims 37, 38, 42, 43, 48 and 49 remain rejected as discussed in this Office Action. Applicant argues that the dependent claims are allowable due to their dependency with respect to independent claim 36. As shown above, the examiner interprets the cited references can still be read on the claimed features. Accordingly, claims 36-54 remain rejected under 35 U.S.C. § 103 (a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven S. Paik
Examiner
Art Unit 2876

ssp